

## **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed March 24, 2006. New claims 29 and 30 are added. Claims 1-30 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **I. PRIOR ART REJECTIONS**

#### **A. Rejection Under 35 U.S.C. §102(b)**

The Examiner rejects claims 1-4, 7-15, 18-20, and 24-28 under 35 U.S.C. § 102(b) as being anticipated by *Fujimura et al.* (United States Patent No. 5,666,450). Because *Fujimura* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

A claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure* ("MPEP") § 2131.

"The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." MPEP 706. Moreover, "[i]n rejecting

claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 CFR 1.104 (emphasis added).

According to the Examiner, *Fujimura* teaches “a chuck configured to support said optical assembly, said chuck being adapted to support said optical assembly without obstructing a view of at least a portion of said lens” (emphasis added), but the Examiner has failed to point out where the chuck is shown or described by *Fujimura*. Rather, the Examiner makes a vague reference to Figure 1, 2, and column 8, lines 55-65. The Applicants have reviewed these portions of *Fujimura* and are unable to identify a chuck. Therefore, the Examiner has failed to set forth a *prima facie* case of anticipation and the Applicant respectfully requests that the rejection of claims 1-4, 7-15, 18-20, and 24-28 be withdrawn.

In addition, according to the Examiner, *Fujimura* teaches “a visual display system adapted to depict a position of said lens relative to said photonic device and to measure said position” (emphasis added), but the Examiner has failed to point out where the visual display system is shown or described by *Fujimura*. Rather, column 8, lines 55-65 relied upon by the examiner merely relate to a camera type device for detecting a focal point of an output from a device such as the one shown in Figures 1 and 2. Therefore, the Examiner has failed to set forth a *prima facie* case of anticipation and the Applicant respectfully requests that the rejection of claims 1-4, 7-15, 18-20, and 24-28 be withdrawn.

Moreover, the Examiner has not shown that the camera in *Fujimura* actually depicts a position of the lens relative to a photonic device. Figures 1 and 2 of *Fujimura* relate to alignment of a semiconductor laser 16 with an optical fiber 9. In direct contrast, claim 1 requires “a visual display system adapted to depict a position of said lens relative to said phontonic device....” *Fujimura*’s system of Figure 1 is simply an active configuration (like that discussed in the “Background” section of the present application) that measures the power received by the optical fiber from the semiconductor laser to determine optical alignment. No depiction of relative positions of a lens and photonic device is taught by Figures 1, 2, discussed in column 8, lines 55-65, or would be required by the teachings of *Fujimura*. Rather, these portions of

*Fujimura* relate to active alignment of a fiber with a laser using the output of the laser, and not a visual depiction of their position, for alignment.

The Examiner has also not shown that *Fujimura* teaches measurement of such position. *Fujimura* essentially “searches” for the focal point of a light transmission from the semiconductor laser by moving in various patterns. See Figure 5 and column 4, lines 31-63; col. 6, lines 22-53. Because *Fujimura* does not determine relative positions of a lens and a photonic device *Fujimura* also does not measure such position. Moreover, because *Fujimura* merely searches for a focal point of as shown in Figure 5, *Fujimura* does not conduct quire measurement of a position.

The Examiner also has not shown that a position of a lens relative to a photonic device is depicted by *Fujimura*. Referring to Figure 2, and its related disclosure, it is clear that *Fujimura* relates to alignment of the a first optical device (including the semiconductor laser chip (1), the photodiode (2), and the spherical lens (6)) with the optical fiber (9). Col. 2, lines 29-32. In Figures 1 and 2 of *Fujimura*, “axis of the semiconductor laser chip (1), the photodiode (2) and the spherical lens (6) [have] already been aligned at the time of producing the device.” Therefore, the position of the lens (6) and semiconductor laser chip (1) need not be aligned by the invention of *Fujimura*.

For at least these reasons the Examiner has not set forth a proper *prima facie* case of anticipation. Therefore, Applicants respectfully request that the rejection of claims 1-4, 7-15, 18-20, and 24-28 under 35 U.S.C. § 102(b) be withdrawn.

#### **B. Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 4, 14, and 21 under 35 U.S.C. § 103 as being unpatentable over *Fujimura* et al. (U.S. Patent No. 5,963,696) in view of the Examiner’s Official Notice.

Claim 4 depends from claim 1, claim 14 depends from claim 12, and claim 21 depends from claim 18. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, claims 4, 14, and 21 are allowable at least for the same reason as the claim(s) from which they depend.

Regarding the Examiner’s Official Notice, the Applicant does not argue that a zoom lens is not well known. However, the issue under section 103 is not whether each single element of a

claim is known, but rather, whether the combination of the elements is know or obvious. It is well established that the mere fact that something is “well-known” cannot serve as a substitute for motivation. *See In re Sponnovle*, 160 USPQ 237, 243 (CCPA 1969) (emphasis added) (“a patentable invention, within the ambit of 35 U.S.C. §103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.”); *also see In re Warner*, 154 USPQ 173, 177 (CCPA 1967) which establishes that the question is never simply what is old; rather, the question is the obviousness of bringing the elements claimed in combination together. Accordingly, merely asserting that particular features of the claims are “old” or “well-known” in the art does nothing to establish a reason why one of ordinary skill in the art would have been led to combine such features and, thus, does not inherently establish obviousness. Therefore, while the Official Notice may establish that a zoom lens exists, it does nothing to establish the obviousness of the combination of elements set forth in claims 4, 14, and 21. As such a *prima facie* case of obviousness has not been set forth and the rejections should be withdrawn.

The Examiner rejects claims 5-6, 16-17, and 22-23 under 35 U.S.C. § 103 as being unpatentable over *Fujimura et al.* (U.S. Patent No. 5,963,696) in view of *Staver et al.* (U.S. Patent No. 5,621, 831).

Claims 5-6 depend from claim 1, claims 16-17 depend from claim 12, and claims 22-23 depends from claim 18. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, claims 5-6, 16-17, and 22-23 are allowable at least for the same reason as the claim(s) from which they depend.

### **CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 25<sup>th</sup> day of September, 2006.

Respectfully submitted,

**/Eric L. Maschoff/ Reg. No. 36,596**

ERIC L. MASCHOFF  
Registration No. 36,596  
Attorney for Applicant  
Customer No. 022913  
Telephone: (801) 533-9800

W:\15436\247.8.1\ML0000003542V001.doc